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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,565	02/07/2001	Murthi Nanja	INTL-0521-US (P10765)	4410
21906	7590	07/20/2005	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			WOO, ISAAC M	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,565

Applicant(s)

NANJA, MURTHI

Examiner

Isaac M. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12-19 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-19 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Applicant's Responses, filed on May 16, 2005 have been considered but they are not persuasive.
2. Claims 1-8, 12-19 and 23-25 are pending.

Response to arguments

3. Applicant's Remarks filed on May 16, 2005, argues that the second reference of Ohashi et al (U.S. Patent No. 6,172,699, hereinafter, "Ohashi") is insufficient for limitations of "single connection session" to combine with Khan (U.S. Patent No. 6,438,575, hereinafter, "Khan").

However, examiner disagrees. From claimed limitations "automatically transferring information to a wireless device at a predetermined time, from two or more web sites in a single connection session", Khan discloses, "automatically transferring information to a wireless device at a predetermined time, from two or more web sites". Ohashi discloses, "transferring data in a single connection session in network" (col. 7, lines 55-66, col. 2, lines 50-67, col. 3, lines 60-67 to col. 4, lines 1-15). "Reason, suggestion, or **motivation to combine two or more prior art references** in single invention **may come from references themselves**, from **knowledge of those skilled in art** that certain references or disclosures in references are known to be of interest in particular field, or from **nature of problem to be solved**;" Pro-Mold and Tool Co. v.

Great Lakes Plastics Inc. U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626
Decided February 7, 1996 Nos. 95-1171, -1181. "Prima facie case of obviousness is established when **teachings of prior art appear to suggest claimed subject matter to person of ordinary skill in art**; it is incumbent upon applicant to go forward with objective evidence of obviousness once prima facie case is established." In re Rinehart (CCPA) 189 USPQ 143 Decided Mar. 11, 1976 No. 75-608 U.S. Court of Customs and Patent Appeals. Thus, Ohashi is sufficient to provide the missing limitation from Khan and combine with Khan.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of

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this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Regarding claim 1, a method of claim 1, can be implemented without computer or machine. Because the limitation of claim 1, "aggregating", "detecting" and "automatically transferring", can be implemented by a human or just abstract idea. Thus, the languages of claim 1 raise a question as to whether the claimed method is directed

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merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible result to from the basis of statutory subject matter under 35 U.S. C. § 101. Therefore, the claimed invention is non-statutory subject matter. The claims should be amended to indicate that the subject matter is implemented by a computer, i.e., a computer implemented method.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 12-19 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al (U.S. Patent No. 6,438,575, hereinafter, "Khan") in view of Ohashi (U.S. Patent No. 6,172,699).

With respect to claims 1, 8, 12, 19 and 23, Khan discloses the method, medium storing instructions processor-based system, and system, aggregating information (web content) from two or more web site (col. 10, lines 44-50) on a client (302, fig.3, col. 11, lines 36-53), see (FIG. 2, FIG. 3, col. 9, lines 55-67 to col. 10, lines 1-26, col.11, lines 36-64, col. 1, lines 43-67 to col. 2, lines 1-34); detecting the occurrence of a predetermined time, see (col. 11, lines 13-22, col. 2, lines 39-48); and automatically

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transferring information to a wireless device at the predetermined time, see (col. 11, lines 13-22, col. 2, lines 39-48, fig. 2, fig.3) from the two or more web sites (col. 10, lines 44-50). Khan does not explicitly disclose, single connection session. However, Ohashi discloses, "plurality of pages of image data is sent in one communication connection session (such a function may be called multi-receiving)", see (col.7, lines 55-66, col. 2, lines 50-67, col. 3, lines 60-67 to col. 4, lines 1-15). This teaches that single connection session provides data transmission (transferring) in network environment. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify Khan by incorporating single connection session as discussed by Ohashi. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a combination because that would provide Khan's system the enhanced auto-data and multiple data transmitting with single communication connection session (without re-connection session) in network communication environment, especially internet communication. Thus, a user can receive information in regular base without the retrying connection session.

With respect to claims 2, 13 and 24, Khan discloses the aggregating the information from two or more web sites on a processor-based system connectable to the wireless device, see (col. 9, lines 55-67 to col. 10, lines 1-26, col. 1, lines 17-67 to col. 2, lines 1-62, FIG. 3, col. 11, lines 37-67 to col. 12, lines 1-51).

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With respect to claims 3 and 14, Khan discloses the receiving user requests for information from web sites and storing the information received from web sites, see (FIG.3, col. 11, lines 37-67 to col. 12, lines 1-51).

With respect to claims 4 and 15, Khan discloses the establishing a telephone connection and during that connection, accessing the requested information from at least one web site, see (col. 2, lines 11-34, col. 9, lines 55-67 to col. 10, lines 1-26).

With respect to claims 5 and 16, Khan discloses the accessing information from at least two web sites using a single connection, see (FIG. 4, col. 17, lines 17-67 to col. 18, lines 1-59).

With respect to claims 6 and 17, Khan discloses the aggregating the information in response to the detection of an event, see (col. 7, lines 8-37, col. 9, lines 55-67 to col. 10, lines 1-26).

With respect to claims 7 and 18, Khan discloses the detecting a period of low activity on a processor-based system, see (fig.1, col. 3, lines 44-65, col. 13, lines 13-62, the computer operating system checks cpu usages or memory usages).

With respect to claim 25, Khan discloses the Internet connection, see (135, fig.1, col. 8, lines 32-54).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
July 14, 2005


JEAN M. CORRIELUS
PRIMARY EXAMINER